

Appl. Serial No.: 10/685,879
Amendment Date: October 13, 2004
Reply to Office Action of October 5, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. Serial No.: 10/685,879
In Re Application of: Beyerle et al
Filed: October 15, 2003

Confirmation No.: 5951
Examiner: Dinh, Tien Quang
Docket No.: Air Force Invention
RL10049
TC/A.U.: 3644
Customer No.: 20146

Title: APPARATUS AND METHOD FOR AERIAL REARMAMENT OF AIRCRAFT

Response to Final Office Action

REQUIREMENT FOR RESTRICTION/ELECTION

Pursuant to 37 CFR §1.143, applicant **provisionally elects claims 1-16** of U.S. Patent Application 10/685,879 for examination in response to Examiner's requirement for restriction. These claims are directed to an apparatus.

Pursuant to 37 CFR §1.142(b) applicant at this time does not intend to cancel non-elected claims 17-23 directed to a method, but acknowledges that these non-elected claims are withdrawn from further consideration by the Examiner. However, applicant respectfully requests that Examiner reinstate claims 17-23 if Examiner determines that applicant has successfully traversed in his remarks below Examiner's arguments for said restriction/election.

ARGUMENTS IN TRAVERSAL OF RESTRICTION

In the Office Action, the Examiner requires a restriction and election of applicant's claims to either an apparatus (claims 1-16) or to a method (claims 17-23) for examination. Applicant provides arguments in opposition to said restriction/election requirement as set forth herein.

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Examiner recites MPEP § 806.05(e) as "...The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process..." Yet, Examiner concludes "...In this case, the *method* can be used to arm ships and land vehicles..."

Applicant argues that "...arm[ing] ships and land vehicles..." constitutes a "...materially different process..." from the aerial rearmament of aircraft. Yet Examiner contends "...[applicant's] *method* can be used to arm ships and land vehicles..." and bases his restriction on such contention. But applicant argues that "...arming ships and land vehicles..." is a *process*, not an apparatus. To have correctly applied MPEP § 806.05(e)(2), Examiner should have argued that applicant's *apparatus* can be used to arm ships and land vehicles – but he did not. Contrary to Examiner's contention, for restriction, the MPEP requires that a claimed *apparatus* can be used to practice a materially *different process* or that a claimed *process* can be practiced by a materially *different apparatus*. Therefore, it appears that Examiner is making his argument for restriction based upon neither MPEP § 806.05(e)(1) nor MPEP § 806.05(e)(2) alone, as required, but rather some combination of the two. This is clearly an incorrect basis for restriction.

Even if Examiner *had* correctly applied MPEP § 806.05(e)(2), applicant argues further yet that there are claimed features of applicant's apparatus that render it patentably and functionally distinct such that it could not "...be used to practice another and materially different process..." such as "...arm[ing] ships and land vehicles...". Applicant now directs Examiner's attention to apparatus claim 2 which recites

"...means for providing aerodynamic lift to said boom..."

and to applicant's method claim 17 which recites

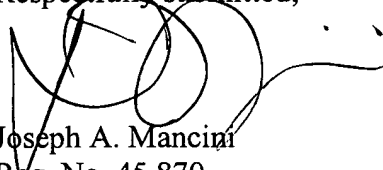
"...providing aerodynamic lift and aerodynamic directional control to said boom..."

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Clearly these limitations of claims 2 and 17 would find no utility in "...arming ships and land vehicles..." as Examiner contends because aerodynamics would serve no function for arming sea or land vehicles. As such, to contend that either applicant's apparatus claims or his method claims can find utility in any application other than rearming aircraft in flight is erroneous, and any argument for restriction so based is incorrect.

It is respectfully requested that Examiner consider applicant's arguments in traversal of the restriction/election requirement and examine all of applicant's claims 1-23 now pending in the subject application. Alternatively, if Examiner is not sufficiently persuaded by applicant's arguments presented herein, then it is requested that applicant's provisionally elected claims 1-16 be presented for examination.

Respectfully submitted,



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